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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/676,009	10/02/2003	Mitchell Schlansky	2195.0010000	6426
26111	7590	12/29/2005	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX PLLC 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			PICKETT, JOHN G	
			ART UNIT	PAPER NUMBER
			3728	

DATE MAILED: 12/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/676,009

Applicant(s)

SCHLANSKY, MITCHELL

Examiner

Gregory Pickett

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office Action acknowledges the applicant's amendment submitted 23 September 2005. Claims 1-23 are pending in the application. Claim 23 is new to the application.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Objections

3. Claim 3 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 3 attempts to broaden the scope of the base claim by using the terminology "means for removably securing said article to a surface", which is broader in scope than the fastener.

Claim Rejections - 35 USC § 102

4. Claims 1-4, 8, and 18-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Kaufman et al (US 2,809,004; hereinafter Kaufman).

Claim 1: Kaufman discloses an article **28** with a base **11**, a first and second arm **20** biased as claimed, and a fastener **12**. The distal ends of the arms of Kaufman are

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curved as claimed. Connection points **14** and **16** are not movable relative to one another.

Claim 2: Kaufman discloses the claimed S-shape.

Claim 3: fastener **12** constitutes a means for securing.

Claim 4: article **28** is made from a single unit of material.

Claim 8: insofar as the device is not positively claimed, Kaufman is capable of holding an electronic device.

Claim 18: Kaufman discloses an article **28** with a base **11**, a first and second arm **20** biased as claimed, and a means for removably securing **12**. The distal ends of the arms of Kaufman are curved as claimed. Connection points **14** and **16** are not movable relative to one another.

Claim 19: Kaufman discloses the claimed S-shape.

Claim 20: article **28** is made from a single unit of material.

5. Claim 23 is rejected under 35 U.S.C. 102(b) as being anticipated by Naylor (US 5,678,204).

Naylor discloses an article **10** (see Figures 1-6) comprising a base **14**, a first arm **20**, and a second arm **22**. The arms of Naylor are shaped and biased as claimed. Although not disclosed by the reference, article **10** of Naylor is capable of receiving and holding an electronic device as claimed.

Claim Rejections - 35 USC § 103

6. Claims 5-7, 21, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaufman in view of Trumbull (US 4,991,801).

Kaufman, as applied to claims 1 and 18 above, discloses the claimed invention except for the coating.

Trumbull teaches coating a holding article for electrical insulation (Col. 3, lines 8-10). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the article of Kaufman with a coating as taught by Trumbull in order to electrically insulate the article. Such a coating provides both a friction-increasing surface and a scratch resistant substance.

7. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kaufman in view of Krillenberger (US 5,307,543).

Kaufman, as applied to claim 1 above, discloses the claimed invention except for the reinforcement ribs.

Krillenberger teaches reinforcement ribs **20 & 22** used to stiffen the area around aperture **18** against bending (Col. 2, lines 30-35). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the article of Kaufman with ribs as taught by Krillenberger in order to stiffen the areas around the fasteners.

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8. Claims 10-13, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Errichiello (US 4,306,737) in view of Genzel (US 5,140,723).

Claim 10: Errichiello discloses a notebook **10** with an article (clip formed by **52/54**) for holding a device having a first arm **52** and second arm **54** biased toward each other. Errichiello merely lacks the express disclosure of a base.

Genzel teaches a separable base **10** with attached arms **12** for separation of the clip and attachment to an article of clothing. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the clips of Errichiello on a separable base as taught by Genzel in order to enable the removal of the clips with subsequent attachment to an article of clothing. Both Errichiello and Genzel disclose clips with arms connected to the base at points that are not movable relative to one another and it would have been obvious to retain this feature in the combination in order to retain the resilient clamping feature of the clips.

Claims 11 and 12: Errichiello discloses the claimed curved S-like shape.

Claim 13: Although Genzel discloses various materials for the base and arms, the reference anticipates each component made of plastic material, in which case it would have been obvious to integrally mold the holder from a single unit of material.

Claim 16: The device is not positively claimed. Errichiello-Genzel is capable of retaining an unspecified electronic device (for example, a pen-shaped, laser pointer device).

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9. Claims 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Errichiello-Genzel as applied to claim 10 above, and further in view of Corey (US 5,059,051).

Errichiello-Genzel merely lacks the coating. Corey teaches a coating **35** over retaining arms **12** for the purpose of damage prevention for the retained objects. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the arms of Errichiello-Genzel with a coating as taught by Corey in order to limit damage potential to retained objects.

10. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Errichiello-Genzel as applied to claim 10 above, and further in view of Krillenberger (US 5,307,543).

Errichiello-Genzel discloses the claimed invention except for the reinforcement ribs.

Krillenberger teaches reinforcement ribs **20 & 22** used to stiffen the base against bending (Col. 2, lines 30-35). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the article of Errichiello-Genzel with ribs as taught by Krillenberger in order to stiffen the base against bending.

Response to Arguments

11. Applicant's arguments filed 23 September 2005 have been fully considered but they are not persuasive.

12. In response to the applicant's arguments concerning Naylor, the terminology "for holding a device" is considered an intended use. The absence of a disclosure relating to the function does not defeat the finding of anticipation since it is well settled that the recitation of a new intended use for an old product does not make a claim to that old product patentable. *In re Schneller*, 44 USPQ 2d 1429 (Fed Cir. 1997); *In re Spada*, 15 USPQ 2d 1655 (Fed. Cir. 1990); and *In re Benner*, 82 USPQ 49 (CCPA 1949).

Conclusion

13. As the examiner presents new grounds of rejection, this action is made **NON-FINAL**.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory Pickett whose telephone number is 571-272-4560. The examiner can normally be reached on Mon-Fri, 11:30 AM - 8:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Greg Pickett
Examiner
23 December 2005


M. D. Nelson
Primary Examiner